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By: Josie E

PATENT
Attorney Docket No. 018563-002400US
Client Ref. No. 9037.ALGP

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

MUHAMMAD CHISHTI *et al.*

Application No.: 09/756,885

Filed: January 9, 2001

For: METHOD AND SYSTEM FOR
DISTRIBUTING PATIENT
REFERRALS

Confirmation No. 6714

Examiner: Lena Najarian

Technology Center/Art Unit: 3626

REPLY BRIEF

Mail Stop Appeal Brief
Commissioner for Patents
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Sir:

Appellant offers this Reply Brief in furtherance of the Examiner's Answer mailed
April 19, 2007.

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1. STATUS OF CLAIMS

Claims 1-30 and 46-59 are currently pending and are the subject of this appeal. No other claims are pending. Claims 31-45 and 60-70 have been canceled.

Claims 1-5 and 12-13 stand rejected under 35 U.S.C. §103(a) over DeBruin-Ashton (U.S. 6,014,629) in view of Falchuk *et al.* (U.S. 2002/0152096 A1), and further in view of Tawil (U.S. 5,225,976).

Claims 6-11 stand rejected under 35 U.S.C. §103(a) over DeBruin-Ashton (U.S. 6,014,629) in view of Falchuk *et al.* (U.S. 2002/0152096 A1) and Tawil (U.S. 5,225,976), and further in view of Kurzius *et al.* (U.S. 6,385,620 B1).

Claims 14, 16-19, 21-22, and 29-30 stand rejected under 35 U.S.C. §103(a) over DeBruin-Ashton (U.S. 6,014,629) in view of Joao (U.S. 2002/0032583 A1).

Claim 15 stands rejected under 35 U.S.C. §103(a) over DeBruin-Ashton (U.S. 6,014,629) in view of Joao (U.S. 2002/0032583 A1), and further in view of Tawil (U.S. 5,225,976).

Claim 20 stands rejected under 35 U.S.C. §103(a) over DeBruin-Ashton (U.S. 6,014,629) in view of Joao (U.S. 2002/0032583 A1), and further in view of Falchuk *et al.* (U.S. 2002/0152096 A1).

Claims 23-28 stand rejected under 35 U.S.C. §103(a) over DeBruin-Ashton (U.S. 6,014,629) in view of Joao (U.S. 2002/0032583 A1), and in view of Tawil (U.S. 5,225,976), and further in view of Kurzius *et al.* (U.S. 6,385,620 B1).

Claims 46-49, 51-52, 55-56, and 58 stand rejected under 35 U.S.C. §103(a) over Tawil (U.S. 5,225,976) in view of Falchuk *et al.* (U.S. 2002/0152096 A1).

Claims 50 and 59 stand rejected under 35 U.S.C. §103(a) over Tawil (U.S. 5,225,976) in view of Falchuk *et al.* (U.S. 2002/0152096 A1), and further in view of DeBruin-Ashton (U.S. 6,014,629).

Claims 53-54 and 57 stand rejected under 35 U.S.C. §103(a) over Tawil (U.S. 5,225,976) in view of Falchuk *et al.* (U.S. 2002/0152096 A1), and further in view of Kurzius *et al.* (U.S. 6,385,620 B1).

2. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Whether claims 1-5 and 12-13 are properly rejected under 35 U.S.C. §103(a) over DeBruin-Ashton (U.S. 6,014,629) in view of Falchuk *et al.* (U.S. 2002/0152096 A1), and further in view of Tawil (U.S. 5,225,976).

Whether claims 6-11 are properly rejected under 35 U.S.C. §103(a) over DeBruin-Ashton (U.S. 6,014,629) in view of Falchuk *et al.* (U.S. 2002/0152096 A1) and Tawil (U.S. 5,225,976), and further in view of Kurzius *et al.* (U.S. 6,385,620 B1).

Whether claims 14, 16-19, 21-22, and 29-30 are properly rejected under 35 U.S.C. §103(a) over DeBruin-Ashton (U.S. 6,014,629) in view of Joao (U.S. 2002/0032583 A1).

Whether claim 15 is properly rejected under 35 U.S.C. §103(a) over DeBruin-Ashton (U.S. 6,014,629) in view of Joao (U.S. 2002/0032583 A1), and further in view of Tawil (U.S. 5,225,976).

Whether claim 20 is properly rejected under 35 U.S.C. §103(a) over DeBruin-Ashton (U.S. 6,014,629) in view of Joao (U.S. 2002/0032583 A1), and further in view of Falchuk *et al.* (U.S. 2002/0152096 A1).

Whether claims 23-28 are properly rejected under 35 U.S.C. §103(a) over DeBruin-Ashton (U.S. 6,014,629) in view of Joao (U.S. 2002/0032583 A1), and in view of Tawil (U.S. 5,225,976), and further in view of Kurzius *et al.* (U.S. 6,385,620 B1).

Whether claims 46-49, 51-52, 55-56, and 58 are properly rejected under 35 U.S.C. §103(a) over Tawil (U.S. 5,225,976) in view of Falchuk *et al.* (U.S. 2002/0152096 A1).

Whether claims 50 and 59 are properly rejected under 35 U.S.C. §103(a) over Tawil (U.S. 5,225,976) in view of Falchuk *et al.* (U.S. 2002/0152096 A1), and further in view of DeBruin-Ashton (U.S. 6,014,629).

Whether claims 53-54 and 57 are properly rejected under 35 U.S.C. §103(a) over Tawil (U.S. 5,225,976) in view of Falchuk *et al.* (U.S. 2002/0152096 A1), and further in view of Kurzius *et al.* (U.S. 6,385,620 B1).

3. ARGUMENT

In Section 9 of the Examiner's Answer mailed 4/19/2007 ("Examiner's Answer"), spanning pages 3-21, the Examiner has repeated the rejections that were previously made of record (see, e.g., Final Office Action, mailed 3/3/2006; Office Action mailed 4/8/2005). Since the rejections and arguments set forth in Section 9, pages 3-21 of the Examiner's Answer merely repeat, nearly verbatim, the rejections as previously made of record, and in the interest of administrative economy and efficiency, these repeated arguments will not be further addressed by Appellant in the present reply, but remain traversed for reasons previously made of record and set forth in Appellant's Appeal Brief.

However, Appellants submit the following remarks in reply to the additional comments made in Section 10 of the Examiner's Answer. Section 10 spans pages 21-28 of the Answer, with pages 21-23 identifying selected remarks found in the Appellant's Appeal Brief (labeled arguments A-G), and pages 23-38 including the Examiner's comments in response to the identified Appellant's remarks.

A. Examiner's Response to Appellant's "Argument A"

At Section 10, page 23-24 (section labeled "Argument A") of the Examiner's Answer, the Examiner cites *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971) in order to justify hindsight reconstruction. However, *In re McLaughlin* is not being properly applied in the present case because 1) the Examiner has merely cited the case with no explanation how it would apply to the facts of the present case; 2) the Examiner has failed to explain how she is taking into account only knowledge that is within the level of one skilled in the art at the time of the invention, while not improperly including knowledge gleaned only from the Appellant's own disclosure.

The Examiner has merely cited a point of law by citing *In re McLaughlin*, but failed to explain how the cited case is believed to apply to the present instance or, more importantly, how the Examiner's rejections of the claims comport with the principle set forth in the cited case. As is well known by the Examiner, it is the Office and not the Appellant that bears the burden of establishing *prima facie* obviousness. Merely citing a point of law with no explanation or application to the present case does little, if anything, to meet this burden. Moreover, the Examiner seems to ignore the principle set forth in the cited provision of *In re McLaughlin* stating that a proper reconstruction of references "takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure..." (cite, emphasis added)

Appellants have addressed the deficiencies of the cited references, both individually and when viewed in combination. The cited references often fail to teach the claim elements for which they are being cited or require contorted interpretations of claim language and/or the teachings in the cited references that appear driven by hindsight analysis. Additionally, Appellants addressed as being deficient the alleged "motivation" cited by the Examiner as the sole reasons for making the proposed combination, and have cited provisions of the cited references that would teach actually away from the proposed combination, as well as numerous differences between the claimed invention and the cited references which would further weigh against a person of ordinary skill making the hypothetical combination proposed.

A case of obviousness requires ascertaining the scope and contents of the cited references, and ascertaining the differences between the cited references and the claims at issue, as well as the level of ordinary skill in the art. *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966); *KSR Intern. Co. v. Teleflex Inc.*, 127 S.Ct. 1727. While specifically demonstrating a teaching, suggestion, or motivation to combine references is not strictly required, "rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR Intern. Co. v. Teleflex Inc.*, at 1741. And "[a] factfinder should be aware, of

course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon ex post reasoning." *Id.* at 1742.

In the present case, against this background, Appellants respectfully maintain that a case of obviousness in view of the cited references would not be found because not only would the proposed combination fail to teach the claimed invention, but only by improperly using Appellants' own claims as a template and under the distortion of hindsight bias could one reconstruct the various elements of the cited references as suggested by the Examiner (which would still fail to teach the claimed invention). As previously made of record, the currently claimed invention is directed to a method of referring patients to practitioners who perform a particular medical procedure, e.g., as recited in claim 1. As set forth in the specification, the medical procedure will typically be new and innovative procedures which are being introduced into the medical community by a company, organization, or institution which has developed the procedure and which has proprietary rights to the procedure. In this way, the company, organization, or institution can maintain control over performance of the procedure by controlling certifying and/or training of the practitioners. The objectives and advantages outlined in the specification are accomplished according to the methods as defined, for example, by claim 1.

In contrast to the present invention, such methods and advantages are neither contemplated nor accomplished by the cited references, either alone or by any reasonable combination. DeBruin-Ashton only vaguely resembles the claimed invention in the sense that the cited reference teaches a physician directory system. However, DeBruin-Ashton teaches referring physicians based on specialty categories rather than a procedure, and does not teach certifying a practitioner to perform a particular procedure and providing a listing of physicians preferentially listed based on the number of times a particular procedure has been performed. Falchuk is unrelated to physician referrals and instead teaches medical consultation for the purpose of awarding continuing medical education (CME) credit. Tawil teaches an automated health benefit processing system for purposes of determining insurance benefit/payment information. Based on the differences between the claimed invention and the cited references, as well as the differences between the systems of the cited references themselves, and provisions of

the references which, if anything, actually teach away from the proposed combination, no reasonable combination of the cited references would teach the claimed invention or even be combined without the use of hindsight.

Accordingly, for the reasons set forth above and those previously made of record, Appellants respectfully maintain that the rejections be reversed and the claims allowed.

B. Examiner's Response to Appellant's "Arguments B & E"

Appellants have previously pointed out that the teachings of DeBruin-Ashton where physicians who have newly joined the health care plan are represented in a higher proportion than physicians that have been with the health care service for an extended period of time (see, e.g., col. 12, lines 47-54 of DeBruin-Ashton cited by the Examiner) is not equivalent to the element of claim 1 for which it is being cited, but, if anything, would produce a result opposite what is disclosed and currently claimed (see, e.g., paragraph bridging pages 11 and 12 of Appellants' Brief filed 1/3/2007). Nevertheless, the Examiner continues to argue the following:

In response to Appellant's second and fifth arguments, the Examiner respectfully submits that DeBruin-Ashton teaches at col. 12, lines 47-54 a selection algorithm where physicians are represented in a higher proportion based on length of time with the health care service provider. As such, if the system is capable of selecting physicians who have newly joined the health care service plan, it is certainly capable of selecting physicians that have been with the health care service provider for an extended period of time. (Examiner's Answer, page 24, first full paragraph)

Appellants maintain that the rejection is overcome for reasons previously made of record and further offer the following remarks in response to the Examiner's arguments.

First, the Examiner's arguments do not address the actual claim language or the steps recited in claim 1. The current claims are not directed to selecting physicians based on length of time with the health care service provider. Claim 1 recites, *inter alia*, "providing to the identified individual patients a list of certified practitioners, selected from the electronic database, wherein those practitioners who have performed more procedures than others of the

practitioners are placed preferentially on the list." This element simply is not taught by DeBruin-Ashton or any of the other cited references taken either individually or in combination. Moreover, length of time with a health care service provider as taught by DeBruin-Ashton would not necessarily have any correlation to number of a particular procedure performed since physicians of any experience level can newly join a health care service, and physicians of any experience level or any length of tenure with a given service can learn new procedures. If anything, preferentially listing physicians who newly join a service, as taught in DeBruin-Ashton, might produce the opposite result of the claimed method.

Second, the Examiner has provided no evidence or reasoning to indicate that the system of DeBruin-Ashton would, in fact, actually be "capable of" anything other than what is taught in the reference. There is certainly no evidence or teaching in the cited reference that the system of DeBruin-Ashton includes programming, selection algorithms, etc. for "providing to the identified individual patients a list of certified practitioners, selected from the electronic database, wherein those practitioners who have performed more procedures than others of the practitioners are placed preferentially on the list," as recited in claim 1, or would otherwise be capable of performing this step without substantial redesign of the system. Appellants respectfully submit that reading such capabilities into the system of DeBruin-Ashton with no objective support or evidence further illustrate improper hindsight analysis.

Third, regardless of the capabilities (i.e., structure) of the system of DeBruin-Ashton, the current claims are directed to methods for referring patients to practitioners, e.g., as recited in claim 1, and merely identifying alleged structural capabilities of system of DeBruin-Ashton is insufficient to establish obviousness of performing the claimed method even if such capabilities were present. As previously set forth, neither DeBruin-Ashton nor any other reference cited by the Examiner, either alone or in combination, would teach each and every element of the claimed methods, e.g., as recited in claim 1, thereby precluding *prima facie* obviousness.

The Examiner further cites to *In re Keller* 642 F.2d 413 and *In re Merck & Co.*, 800 F.2d 1091 for the indication that "one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references" (Examiner's Answer,

page 24). Again, the Examiner has merely provided a legal citation with no indication how the citation is believed to apply to the facts of the case.

In the present case, however, Appellants have properly addressed both 1) the individual references with respect to the individual claim elements that the Examiner alleges are being taught; and 2) the deficiency of the teachings of the references when viewed in combination. For example, attention is respectfully drawn to page 14 of Appellants Brief, where Appellants further discuss the hypothetical combination of references proposed by the Examiner. Not only do the individual references often fail to provide the teachings for which they have been cited, but even if, for arguments sake, DeBruin-Ashton, Falchuk and Tawil were combined, the combination would still fail to teach each and every element of claim 1, for the reasons previously made of record.

C. Examiner's Response to Appellant's "Argument C"

Appellants have traversed the allegation that Falchuk teaches "certifying a group of practitioners to perform a medical procedure," as recited in claim 1 (see, e.g., Appellant's Brief, pages 11-12). In response to Appellants' remarks pointing out the differences between the steps of the claimed invention and the teachings of Falchuk, the Examiner continues to maintain that the certifying step of claim 1 is equivalently taught in the cited reference. The following arguments, *inter alia*, are presented in the Examiner's Answer, pages 23-25, to justify the Examiner's position:

"...words of the claim are generally given their ordinary and customary meaning, unless it appears from the written description that they were used differently by the Appellant."

...it would **not** be proper for the examiner to give words of the claim special meaning when no such special meaning has been defined by the Appellant in the written description."

"...the specification does not set out a special definition explicitly and with 'reasonable clarity, deliberateness, and precision' of 'certifying'"

Despite the Examiner's repeated insistence that no special meaning or definition of the phrase "certifying a group of practitioners to perform a medical procedure" (see claim 1) is set forth in the specification or otherwise warranted, it is the Examiner that actually applies a special definition to the claim language that goes well beyond a plain and ordinary reading of the claim. Appellants submit that properly applying an ordinary meaning to cited claim phrase would actually preclude reading the phrase as reasonably including the system of Falchuk. For example, attention is respectfully drawn to the allegation by the Examiner that the "accreditation" taught at paragraphs 0021 and 0030 of Falchuk is equivalent to "certifying a group of practitioners to perform a medical procedure", as recited in claim 1 (see, e.g., Examiner's Answer, page 4, lines 10-12). Paragraph 0030 of Falchuk provides the following:

The accreditation module 70 administers a database 72 which records information concerning the consultation sessions and produces accreditation reports 75 which may be submitted to the responsible accreditation authority to certify that the requesting physician is entitled to continuing medical education (CME) credits based on his or her participation in the consultation process....

The credits accumulated by individual primary care physicians who have participated in learning sessions are then detailed in the CME credit report 75 which is thereafter produced for submission to the responsible accrediting body as indicated at 82.

(Falchuk, paragraph 0030, emphasis added)

Giving the words of the claims their ordinary and customary meaning, no reasonable interpretation of the phrase "certifying a group of practitioners to perform a medical procedure", as recited in claim 1, would include recording a consultation session between a single primary physician and a specialist, and submitting a resulting CME credit report to the responsible accrediting body, as taught by Falchuk. Reading the element of the claim in light of the specification would even more clearly indicate that the claimed methods would not reasonable include the system of Falchuk. As such, neither Falchuk nor any other cited reference, alone or in combination, teaches the "certifying" step recited in claim 1.

D. Examiner's Response to Appellant's "Argument D"

The Examiner again cites to *In re Keller* 642 F.2d 413 and *In re Merck & Co.*, 800 F.2d 1091 for the indication that "one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references" (Examiner's Answer, page 26). Again, the Examiner has merely provided a legal citation with no indication how the citation is believed to apply to the facts of the case.

As set forth above, however, Appellants have properly addressed both 1) the individual references with respect to the individual claim elements that the Examiner alleges are being taught; and 2) the deficiency of the teachings of the references when viewed in combination (see, e.g., Appellants' Brief, page 14). The individual references often fail to provide the teachings for which they have been cited. And even if, for arguments sake, DeBruin-Ashton, Falchuk and Tawil were combined, the combination would still fail to teach each and every element of claim 1, for the reasons previously made of record.

With specific respect to Tawil, while the cited reference teaches a database including the number of times a provider has performed a procedure within a given time and providing that information on an individual practitioner basis, Tawil does not teach searching, listing, or otherwise organizing a group of practitioners based on this parameter. The Examiner has proposed combining Tawil with other references (DeBruin-Ashton and Falchuk) that similarly lack this teaching. This fact, in addition to other elements of the claims that are lacking from the combined teachings and numerous differences between the cited references and the claimed invention, supports Appellants' contention that no reasonable combination of the cited references would teach or suggest the claimed invention, e.g., as recited in claim 1.

E. Examiner's Response to Appellant's "Argument F"

The cited reference of Kurzius is directed to a system for automated employment candidate recruiting. Appellants respectfully maintain that the fact that Kurzius has nothing to do with the subject matter of the claims, or referring patients to medical practitioners, should be considered in determining the issue non-obviousness.

Appellants submit, as previously made of record, that the cited reference of Kurzius fails to teach the claim element for which it is being cited by the Examiner. With specific regard to dependent claims 6-11, Kurzius is cited by the Examiner as allegedly teaching placing candidates into tiers based on job experience and proficiency level. The provision of Kurzius cited by the Examiner (col. 17, lines 48-52) teaches that an employment candidate may indicate, in a "candidate proficiency form," employment qualification information such as years of experience and proficiency level (e.g., beginner, intermediate, etc.).

Kurzius, however, fails to teach medical practitioners placed into tiers based on the number of procedures performed and wherein practitioners from higher tiers are preferentially placed on lists, as recited in claim 6. Allowing an employment candidate to indicate, in completing a candidate proficiency form, proficiency level selected from a list of categories (e.g., beginner, intermediate, etc.) simply is not equivalent to placing medical practitioners into tiers based on the number of medical procedures performed, as alleged by the Examiner (Office Action mailed 4/8/2005, pages 8-9). Kurzius also fails to provide the teachings that are missing from DeBruin-Ashton, Falchuk, and Tawil. As such, the cited references fail to teach or suggest each and every element of independent claim 1 or dependent claims 6-11.

Regarding Appellants' previous remarks regarding no reason or suggestion to combine the references, Appellants point out that the Examiner specifically cited a provision of Kurzius as providing a "motivation" as the reason for proposing the specific combination of references. Therefore, in addressing this alleged "motivation" Appellants are specifically addressing the Examiner's stated case for obviousness. In particular, the Examiner has cited col. 15, lines 45-50 of Kurzius as providing a "motivation" to combine the references as proposed, but the cited provision merely repeats the employment screening tools of Kurzius and adds little to the rejection. Appellants respectfully submit that the cited provision does not provide any "articulated reasoning with some rational underpinning to support the legal conclusion of obviousness" (see, e.g., *KSR Intern. Co. v. Teleflex Inc.*, at 1741) In fact, the Examiner's analysis would seem to disregard the differences between the claimed subject matter and the cited

reference, including the fact that Kurzius has nothing to do with the subject matter of the claims, or referring patients to medical practitioners.

F. Examiner's Response to Appellant's "Argument G"

Appellants have traversed the allegation that Joao teaches "certifying dental practitioners to perform a dental procedure", as recited in claim 14 (see, e.g., Appellants' Brief, pages 20-23). Nevertheless, the Examiner maintains that the reference at paragraph 167 of Joao, where the term "dental training" is listed among a voluminous list of file types that may be contained in a database, allegedly teaches the specific step of certifying dental practitioners to perform a dental procedure, as recited in claim 14. The Examiner cites to the reasoning provided in "the response to Argument C above" to support maintaining the rejection. As noted above, the Examiner states in "the response to Argument C" that no special definition to "certifying" step is found in the specification and, therefore, the ordinary and customary meaning of the phrase should apply.

Similar to above, however, properly applying an ordinary meaning to the cited claim phrase of "certifying dental practitioners to perform a dental procedure" would actually preclude one of ordinary skill reading the phrase as reasonably including the mere reference to a type of file in a database of Joao. Furthermore, reading the claim phrase in light of the specification would even more clearly indicate that the "certifying" step is not met by the vague reference to a type of database file found in Joao. As such, neither Joao nor any other cited reference, alone or in combination, teaches the "certifying" step recited in claim 14.

4. CONCLUSION

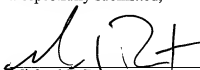
For the reasons set forth above, it is respectfully submitted that the rejection should be reversed.

If for any reasons the Examiner believes a telephone conference would in any way expedite resolution of the issues raised in this appeal, the Examiner is invited to telephone the undersigned at 206-467-9600.

Dated: _____

6/19/2007

Respectfully submitted,



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